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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,026	02/03/2004	Jerry L. Brown	713629.new	2025
27128	7590	09/13/2005		
BLACKWELL SANDERS PEPER MARTIN LLP 720 OLIVE STREET SUITE 2400 ST. LOUIS, MO 63101			EXAMINER TESKIN, FRED M	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/708,026	Applicant(s) BROWN ET AL.	
	Examiner Fred M Teskin	Art Unit 1713	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-24 is/are allowed.
- 6) ☒ Claim(s) 25-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

The reply of October 15, 2004, has been fully considered with the following effect:

(1) the prior art rejection based on Broering et al or Simon et al is maintained and applicants' arguments found unpersuasive as detailed below;

(2) the Section 112 rejection of the previous Office action has been obviated by appropriate claim amendments; and

(3) claims 1-24 are allowable over the prior art of record for the reasons set forth in the previous Office action.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 25-27 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 4252969 to Broering et al or U.S. 5736621 to Simon et al.

The basis of the rejection is adequately set forth in the previous Office action and that explanation is incorporated herein by reference.

Applicant's arguments filed October 15, 2004, have been fully considered but are not persuasive of error in the repeated rejection.

Applicant traverses the rejection, firstly pointing to paragraph 0014 of the specification, which is said to explain that the "process of manufacturing" to which this

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invention pertains is “known polymer manufacturing methods including extrusion, molding and equivalent methods.” Based on the cited description, applicant appears to be arguing that the “manufacturing” process of the present invention does not embrace the polyethylene processing or (co)polyester preparation procedures disclosed by Broering et al and Simon et al, respectively.

Examiner disagrees and notes that in the quoted expression, the enumerated methods (extrusion, molding) are introduced by the term “including”, which is synonymous with “comprising” and thus open-ended (see MPEP 2111.03). As such, it does not exclude other non-enumerated methods. The expression “process of manufacturing” is therefore construed broadly to include any known polymer manufacturing method. In this regard, the submissions from *Kirk-Othmer* and *Encyclopedia of Polymer Science and Technology* are cited as evidence of the term “polymer manufacturing” being ordinarily used in the art to refer to (co)polymer preparation and processing procedures. (See, Tarmy, second paragraph of Section 9.1 and Guest et al, title of Section 3.)

Accordingly, it is determined that no special definition is set forth by applicant that limits the “manufacturing” processes of the present invention to post-polymerization shaping operations such as extrusion and molding and that, therefore, claims 25-27 are readable on articles produced by the processes of the applied art wherein a heat transfer fluid is used to control temperature during the processing of polyethylene (Broering) and the preparation of (co)polyesters (Simon).

Applicants further note that the above-cited portion of the specification states that the actual transfer of heat is performed by the “vaporized portion of the heat transfer fluid that is being used in conjunction with the manufacture of the temperature-sensitive polymers.”

The above-quoted language, however, is nowhere recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In any event, it is well settled that product-by-process claims, like claims 25-27, are not limited to the manipulations of the recited steps, only the structure implied by the steps. “Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process.” *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

Applicants next assert that the boiling point of the heat transfer fluid is a defining aspect of the invention and that, according to the specification, paragraph 0002, a boiling point difference exceeding two degrees centigrade *can* lead to a different crystallization behavior, and with this change, the article *can* exhibit modified bulk and surface characteristics.

The cited statements as to certain changes in the article that *can* occur as a result of a 2°C boiling point difference are, however, unsubstantiated by any objective evidence in the record. There is, e.g., no comparative data demonstrating the effect of

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using a heat transfer fluid having a boiling point range as claimed to control temperature in a polymer manufacturing process on the bulk and/or surface characteristics of the resultant article. The unsupported allegations in the specification are not probative of patentability as to the article claimed in claims 25-27.

Applicant also asserts that the products of the claimed process are improved over those of the prior art, relying for support on the statement in paragraph 0008 of the specification that an object of the present invention is to provide a process with minimal temperature variations, even as low as within 1°C variation.

However, there is no positive limitation on temperature variation anywhere in the claims. Nor has applicant alleged, much less shown, that such a minimal temperature variation inheres merely in operating within the scope of the claims and, moreover, necessarily results in an unobvious difference in the claimed products over the prior art products.

As applicant has not met the burden of coming forward with evidence establishing an unobvious difference between the claimed products and the prior art products, *In re Marosi*, 218 USPQ 195 (Fed. Cir. 1983), the continued rejection of claims 25-27 is still deemed to be tenable and therefore is maintained.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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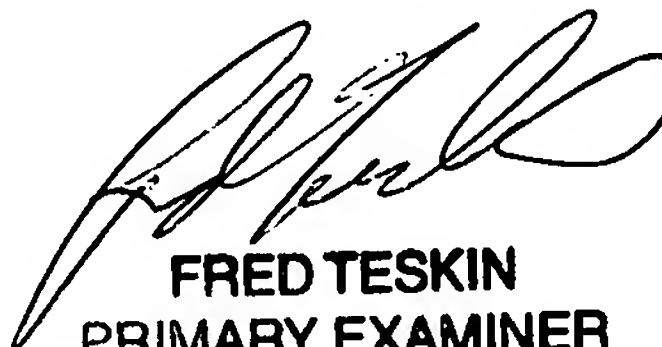
TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner F. M. Teskin whose telephone number is (571) 272-1116. The examiner can normally be reached on Monday through Thursday from 7:00 AM - 4:30 PM, and can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The appropriate fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FMTeskin/07-31-05

  
FRED TESKIN  
PRIMARY EXAMINER  
1713